

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL A. GOMPERTZ
and
ART B. DAWSON

Appeal No. 97-2650
Application No. 08/489,257¹

ON BRIEF

Before COHEN, FRANKFORT, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 12 through 14 and 17 through 19, which are all of the claims pending in this application.²

¹ Application for patent filed June 14, 1995. According to the appellants, the application is a continuation of Application No. 08/381,016, filed January 30, 1995, now abandoned, which was a continuation of Application No. 08/025,105, filed March 2, 1993, now abandoned.

² Claims 13, 14 and 17 through 19 were amended subsequent to the final rejection.

Appeal No. 97-2650
Application No. 08/489,257

We REVERSE.

BACKGROUND

The appellants' invention relates to an electrically operated barrier system for preventing access to a passageway. An understanding of the invention can be derived from a reading of exemplary claim 12, which appears in Appendix B of the appellants' brief.

Claims 12 through 14 and 17 through 19 stand rejected under 35 U.S.C. § 112, first paragraph, for failing to provide an adequate written description of the invention.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the examiner's answer (Paper No. 28, mailed February 12, 1997) for the examiner's complete reasoning in support of the rejection, and to the appellants' brief (Paper No. 27, filed October 23, 1996) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and

drawings, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we will not sustain the examiner's rejection under 35 U.S.C. § 112, first paragraph. Our reasoning for this determination follows.

The examiner rejected claims 12 through 14 and 17 through 19 under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification. The specification was objected to as failing to provide an adequate written description of the invention. Specifically, the examiner stated (answer, pp. 3-4) that

[t]he specification fails to disclose the structure which comprises the following elements: chain end coupler; chain guide; taut switch; sensor plate; indicator arm; drive member, drive shaft, and gear box as to their structural relationship with the sprocket pulley; equipment plate; it is not known how the solenoid bolt 27 as indicated in the amended drawings passes through the chain guide 32 and the chain end coupler 31 inasmuch as the drawings do not illustrate an aperture to allow the passage of the solenoid bolt 27 therethrough; it is not known what structure permits movement of the sprocket pulley; it is not known what circuitry the circuit board 41 comprises.

It is well settled that the written description and enablement requirements are separate and distinct from one another and have different tests. See In re Wilder, 736 F.2d 1516, 1520, 222 USPQ 369, 372 (Fed. Cir. 1984); In re Barker, 559

F.2d 588, 591, 194 USPQ 470, 472 (CCPA 1977); and In re Moore, 439 F.2d 1232, 1235-36, 169 USPQ 236, 239 (CCPA 1971). However, because of the variety of concerns stated by the examiner, it is not entirely clear to us exactly which requirement the examiner's rejection is based upon. Accordingly, we will review the claims as having been rejected under both the written description and enablement requirements.

Written description

The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. Further, the content of the drawings may also be considered in determining compliance with the written description requirement. See Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555, 19 USPQ2d 1111, 1116 (Fed. Cir. 1991) and In re Kaslow, 707 F.2d 1366, 217 USPQ 1089, 1096 (Fed. Cir. 1983). Thus, a rejection based on the written description requirement is fully defeated by a specification which describes the invention in the same terms as

the claims. See In re Bowen, 492 F.2d 859, 864, 181 USPQ 48, 52 (CCPA 1974).

We have reviewed the specific concerns stated by the examiner in this rejection of claims 12 through 14 and 17 through 19, but find nothing therein which supports a rejection based upon the written description requirement of 35 U.S.C. § 112, first paragraph. In addition, we have reviewed the subject matter recited in the claims under appeal and have determined that these claims do comply with the written description requirement of 35 U.S.C. § 112, first paragraph.

For the reasons set forth above, the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the subject matter recited in claims 12 through 14 and 17 through 19.

Enablement

An analysis of whether the claims under appeal are supported by an enabling disclosure requires a determination of whether that disclosure contained sufficient information regarding the subject matter of the appealed claims as to enable one skilled in

the pertinent art to make and use the claimed invention. The test for enablement is whether one skilled in the art could make and use the claimed invention from the disclosure coupled with information known in the art without undue experimentation. See United States v. Telectronics, Inc., 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988), cert. denied, 109 S.Ct. 1954 (1989); In re Stephens, 529 F.2d 1343, 1345, 188 USPQ 659, 661 (CCPA 1976).

In order to make a rejection, the examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. See In re Wright, 999 F.2d 1557, 1561-62, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993) (examiner must provide a reasonable explanation as to why the scope of protection provided by a claim is not adequately enabled by the disclosure). A disclosure which contains a teaching of the manner and process of making and using an invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as being in compliance with the enablement requirement of 35 U.S.C. § 112, first paragraph, unless there is a reason to doubt the objective truth of the statements contained therein

which must be relied on for enabling support. Assuming that sufficient reason for such doubt exists, a rejection for failure to teach how to make and/or use will be proper on that basis. See In re Marzocchi, 439 F.2d 220, 223, 169 USPQ 367, 369 (CCPA 1971). As stated by the court, "it is incumbent upon the Patent Office, whenever a rejection on this basis is made, to explain why it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement. Otherwise, there would be no need for the applicant to go to the trouble and expense of supporting his presumptively accurate disclosure." In re Marzocchi, 439 F.2d at 224, 169 USPQ at 370.

Thus, the threshold step in resolving this issue as set forth supra is to determine whether the examiner has met his burden of proof by advancing acceptable reasoning inconsistent with enablement. This the examiner has not done.

While the examiner is correct that the drawings do not illustrate an aperture to allow the passage of the solenoid bolt 27 through the chain guide 32, the original specification (page

9, lines 22-29) clearly teaches that in an alternative embodiment the solenoid bolt passes through one side of the chain guide 32, through the chain end coupler 31 and through the other side of the chain guide 32 to lock the chain structure in the raised position.

As to the examiner's inquiry as to what structure permits movement of the sprocket pulley, the original disclosure clearly shows in Figures 3 and 7 that (1) the sprocket pulley is mounted upon a support (denoted by # 12) which is spring biased away from plate 24³ (position shown in Figure 3), and (2) the sprocket pulley and support (denoted by # 12) can be moved closer to plate 24 by compressing the spring (position shown in Figure 7). With regard to what circuitry the circuit board 41 comprises, we agree with the appellants' view (brief, pp. 11-12) that the design of the circuit board is well within the skill of an artisan.

For the reasons set forth above, it is our view that the original disclosure contained sufficient information regarding

³ In the amendment filed June 30, 1994, the appellants changed "24" to --26-- on page 6 and in Figures 3 and 7.

the subject matter of the appealed claims as to enable one skilled in the pertinent art to make and use the claimed invention.

CONCLUSION

To summarize, the decision of the examiner to reject claims 12 through 14 and 17 through 19 under 35 U.S.C. § 112, first paragraph, is reversed.

REVERSED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
CHARLES E. FRANKFORT)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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Appeal No. 97-2650
Application No. 08/489,257

Page 12

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APPEAL NO. 97-2650 - JUDGE NASE
APPLICATION NO. 08/489,257

APJ NASE

APJ FRANKFORT

APJ COHEN

DECISION: **REVERSED**

Prepared By: Delores A. Lowe

DRAFT TYPED: 19 May 98

FINAL TYPED: